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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/864,761	05/23/2001	Sharron Gaynor Penn	AEOMICA_X_I	6802

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NEW YORK, NY 10020-1105

EXAMINER

GOLDBERG, JEANINE ANNE

ART UNIT	PAPER NUMBER
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1634

DATE MAILED: 06/24/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/864,761

Applicant(s)

PENN ET AL.

Examiner

Jeanine A Goldberg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 December 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-58 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-58 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1- 48, drawn to a nucleic acid probe, a set of single exon nucleic acid probes and microarrays comprising a plurality of single exon nucleic acid probes and method of measuring human gene expression using a microarray which comprises a plurality of nucleic acids, classified in class 536, subclass 23.1 or 435, subclass 6; 435/287.2 for example.
  - II. Claims 49-50, drawn to polypeptides, classified in class 530, subclass 350.
  - III. Claim 51, drawn to antibodies, classified in class 424, subclass 124.1.
  - IV. Claims 52-54, drawn to a method of selling and/or licensing probes or microarrays and method of providing human gene expression data by subscription, classified in class 705, subclass 1.
  - V. Claim 55, 57, drawn to a computer readable storage medium, classified in class D14, subclass 474.
  - VI. Claim 56, drawn to a computer system comprising a processor, classified in class D14, subclass 300.
  - VII. Claim 58, drawn to a method of financing a company that makes and sells single exon probes, single exon microarrays, or expression data, classified in class 705, subclass 35.

**Restriction Requirement Applicable to All Groups:**

2. Each sequence is patentably distinct because they are unrelated sequences, i.e. these sequences are unrelated because the protein encoded by these sequences differ in structure and in function and in biological activity. Further, even where the nucleic acid changes have no effect on protein structure or function, these sequences themselves represent allelic variations which have different diagnostic and therapeutic implications. A restriction is applied to each Group. For an elected Group drawn to amino acid sequences, the Applicants must further elect a single amino acid sequence. For an elected Group drawn to nucleotide sequences, the Applicants are permitted to elect a single nucleic acid sequences (See MPEP 803.04).

3. In the event that Group I is selected, the following requirement is applicable. Claims 1-31, 48 rely upon a single sequence. Applicant is required to select a single sequence for restriction purposes. Claims 35-44 are directed to a plurality of nucleic acids of a set of between 50-20,000 probes. Applicant is required to select a single set of 50-20,000 probes which contains the nucleic acid selected to Claims 1-31,48.

Claims 1-32 contain over 16,460 individual, independent and distinct nucleotide sequences in alternative form. Accordingly, these claims are subject to restriction under 35 U.S.C. 121 as outlined in 1192 O.G. 68 (November 19, 1996).

Nucleotide sequences encoding different proteins are structurally distinct chemical compounds and are unrelated to one another. These sequences are thus

deemed to normally constitute independent and distinct inventions within the meaning of 35 U.S.C. 121. Absent evidence to the contrary, each such nucleotide sequences are presumed to represent an independent and distinct invention, subject to a restriction requirement pursuant to 35 U.S.C. 121 and 37 CFR 1.141 et seq.

Similarly, Groups II and III drawn to multiple peptides and antibodies. Each of these sequences are structurally distinct chemical compounds and are unrelated to one another.

Should applicant traverse on the ground that the nucleic acids are not patentably distinct, applicant should submit evident or identify such evidence now of record showing the species to be obvious variant or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other inventions.

4. The inventions are distinct, each from the other because of the following reasons:

A) The inventions are distinct, each from the other because of the following reasons: The inventions of Groups I, II, III, V, VI are patentably distinct because they are drawn to different products having different structures and functions. The nucleic acid of Group I is composed of nucleotides linked in phosphodiester bonds and arranged in space as a double helix. The polypeptide of Group II is composed of amino acids linked in peptide bonds and arranged spatially in a number of different tertiary structures

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including alpha helices, beta-pleated sheets, and hydrophobic loops (transmembrane domain). The antibody of Group III is also composed of amino acids linked in peptide bonds and arranged spatially in a very specific tertiary structure that allows that antibody to specifically bind to particular regions, i.e. epitopes, of the encoded polypeptide. Further, antibodies are glycosylated and their tertiary structure is unique, where four subunits (2 light chains and 2 heavy chains) associated via disulfide bonds into a Y-shaped symmetric dimer. The storage medium of Group V is a plastic or metal substance which functions in a computer. The computer system is a complex machine which contains components for information processing. Furthermore, the products of Groups I, II, III, V, VI can be used in materially different processes, for example, the DNA of Group I can be used in hybridization assays, the antibody of Group III can be used in immunoassay, the polypeptide of Group II can be used to make fusion protein with an enzymatic function. Consequently, the reagents, reaction conditions, and reaction parameters required to make or use each invention are different. Therefore, the inventions of Groups I, II, III, V, VI are patentably distinct from each other.

B) Group (I, II, III) and (IV, VIII) are patentable distinct inventions because the nucleic acid, polypeptide, antibodies of Group I, II, III are not relied upon in the method of Group IV and VIII. Instead Group IV and VIII uses computerized information and knowledge. Therefore, the inventions are novel and unobvious over one another.

C) Inventions (V and VI) and IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially

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different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the computer readable storage medium and the computer system can be used in numerous other ways such as composing documents or saving and retrieving saved documents.

D) The inventions of Group IV and VIII are patentably distinct methods because they each have different objectives, different uses, different reagents and different method steps. The method of Group IV is for selling and/or licensing a database. Alternatively, the method of Group VIII is for selling company stock. Therefore the methods are distinct over one another.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by the different classifications and their divergent subject matter, restriction for examination purposes as indicated is proper.

6. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).


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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Jeanine Goldberg whose telephone number is (703) 306-5817. The examiner can normally be reached Monday-Friday from 8:00 a.m. to 5:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jones, can be reached on (703) 308-1152. The fax number for this Group is (703) 305- 3014.

Any inquiry of formal matters can be directed to the patent analyst, Pauline Farrier, whose telephone number is (703) 305-3550.

Any inquiry of a general nature should be directed to the Group receptionist whose telephone number is (703) 308-0196.

  
Jeanine Goldberg  
June 21, 2002

  
W. Gary Jones  
Supervisory Patent Examiner  
Technology Center 1600